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TO: Office of Petitions

DATE: October 7, 2003

COMPANY: United States Patent and Trademark Office

FACSIMILE NO.: (703) 308-6916

FROM: Richard J. Godlewski

NO. OF PAGES 30
(including this cover sheet).

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In Re Application of: Hartley et al.

Atty. Docket No.: PA-5169-CON

Group Art Unit: 3731

Serial No.: 09/449,270

Examiner: Tan-Uyen T. Ho

Filed: November 24, 1999

Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A PROSTHESIS

Please enter and make of record the enclosed Petition To Withdraw The Holding of Abandonment Under 37 CFR 1.181 to application Serial No. 09/449,270. The following documents are enclosed with this transmission:

Transmittal of Petition To Withdraw The Holding of Abandonment Under 37 CFR 1.181 (2 pages)

Petition to Withdraw The Holding of Abandonment Under 37 CFR 1.181 (4 pages)

December 18, 2002, Final Office Action (7 pages)

March 28, 2003, Amendment and Response to Final Office action (8 pages)

April 8, 2003, Interview Summary (3 pages)

August 14, 2003, Advisory Action (3 pages)

October 3, 2003, Notice of Abandonment (2 pages)

Richard J. Godlewski

Richard J. Godlewski
Registration No. 30,056
(812) 330-1824

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CERTIFICATION OF FACSIMILE TRANSMISSION	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office on the date shown below.	
<u>October 7, 2003</u> Date	<u>Pam Garwood</u> (Typed or printed name of person signing certification) <u>Pam Garwood</u> Signature

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Hartley et al.

Atty. Docket No.: PA-5169-CON

Customer No.: 9896

Serial No.: 09/449,270

Group Art Unit: 3731

Filed: November 24, 1999

Examiner: Uyen T. Ho

Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A PROSTHESIS

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

**TRANSMITTAL OF PETITION TO WITHDRAW THE HOLDING
OF ABANDONMENT UNDER 37 CFR 1.181**

SIR:

Please make of record the following papers relating to the above-identified application:

Petition to Withdraw The Holding of Abandonment Under 37 CFR 1.181
(4 pages)

December 18, 2002, Final Office Action (7 pages)

March 28, 2003, Amendment and Response to Final Office action (8 pages)

April 8, 2003, Interview Summary (3 pages)

August 14, 2003, Advisory Action (3 pages)

October 3, 2003, Notice of Abandonment (2 pages)

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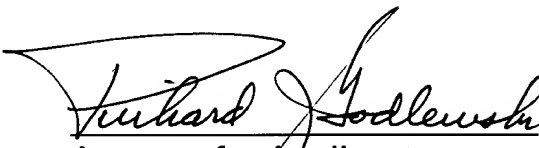
No additional fee is required. In the event of improper payment of required fee, the Commissioner is authorized to charge or to credit Deposit Account No. 13-2528 as required to correct the error.

Please address all correspondence to:

Richard J. Godlewski
Patent Attorney
P.O. Box 2269
Bloomington, IN 47402-2269
812-330-1824

Respectfully,

Date: Oct. 7, 2003


Attorney for Applicants
Richard J. Godlewski
Reg. No. 30,056

Serial No. 09/449,270

PATENT



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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

October 7, 2003 Pamm Garwood
Date (Typed or printed name of person signing certification)
Signature

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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Hartley et al.

Atty. Docket No.: PA-5169-CON

Customer Number: 9896

Serial No.: 09/449,270

Group Art Unit: 3731

Filed: November 24, 1999

Examiner: Tan-Uyen T. Ho

Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A PROSTHESIS

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181**

In response to the Advisory action, dated August 14, 2003, Paper No. 16, and the Notice of Abandonment, dated October 3, 2003, Paper No. 17, applicants petition and request the Commissioner under 37 CFR 1.181 to withdraw the abandonment of the application and the finality of the Office action, dated December 18, 2002, Paper No. 12. It is also requested that a new non-final Office action be sent to the applicants.

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In support of this petition and request, applicants received the enclosed final Office action, dated December 18, 2002, Paper No. 12, in which claims 1-63 were pending and claims 12-17 and 43-63 were withdrawn from consideration. Claims 24-42 were allowed, and claims 1-11 and 18-23 were rejected. In response, applicants submitted the enclosed March 28, 2003, Amendment and Response, along with a Petition and Fee for a One Month Extension of Time. In the reply, the applicants traversed the Examiner's conclusion that applicants' previous amendment necessitated the new ground of rejection under 35 USC 112, second paragraph. This rejection was being raised for the first time by the Examiner in the final Office action of which the applicants' previously submitted amendment had no bearing or impact thereon. In view thereof, applicants submitted that making the action of December 18, 2002, final was improper, and it was requested that the finality of the December 18, 2002, Office action be withdrawn.

On April 7, 2003, Examiner Ho and applicants' attorney had a telephone interview in which an agreement was reached with respect to the claims. The Examiner withdrew the finality of the previous Office action and indicated that a new Office action would be sent to the applicants. The enclosed interview summary dated April 8, 2003, evidences such agreement and the action of Examiner Ho. As a result of this agreement, applicants' attorney understood that the finality of the Office action and the statutory six-month statutory period for reply had been withdrawn.

For sake of discussion, the six-month statutory period for reply to the December 18, 2002, final Office action expired on June 18, 2003. However after receipt of the interview summary, no communication was received from the Examiner by or on June 18, 2003.

On August 14, 2003, an Advisory action was mailed and received on August 18, 2003, in which the Examiner indicated that the March 28, 2003 reply filed by the applicants had failed to place the application in condition for allowance. As indicated in the enclosed Advisory action, the period to reply to the Advisory action expired on the mailing date of the Advisory action or the date set forth in the final rejection, whichever is later. Accordingly, as previously discussed, the

six-month statutory period for reply had expired on June 18, 2003, nearly two months prior to the mailing of the Advisory action. In addition, since the applicants did not receive the Advisory action until August 18, 2003, four days after the mailing date, the application was abandoned before the applicants received the Advisory action. The Examiner indicated that the proposed amendments of the March 28, 2003, reply raised new issues and would require further consideration and/or search. In addition, in the Note portion of the Advisory action, the Examiner indicated that after careful reconsideration of this application, the claim rejection under 35 USC 112 of the final Office action was withdrawn. Accordingly, the Examiner concluded that the finality of the previous Office action was proper.

Applicants strongly traverse such conclusion and submit that this is contrary to the April 7, 2003, interview summary in which the Examiner indicated the finality of the previous Office action was withdrawn and not just the withdrawal of the claim rejection under 35 USC 112, second paragraph. In addition, the Examiner indicated that a new Office action would be sent to the applicants. Applicants submit that the Examiner was at least obligated to notify applicants' attorney that she had changed her mind concerning the withdrawal of the final Office action before the expiration of the six-month statutory period for reply which expired on June 18, 2003, not two months afterward when the Advisory action was sent to the applicants' attorney. As a result of the Examiner's reversal of her written statement to withdraw the finality of the December 18, 2002 Office action, applicants have filed this petition and request under 37 CFR 1.181 to withdraw the holding of abandonment. This petition is being filed within two months of the August 14, 2003, Advisory action and the October 3, 2003, Notice of Abandonment as required under 37 CFR 1.181(f). As further required under 37 CFR 1.181(c), reexamination and reconsideration under 37 CFR 111 of this application was requested on page 5 of applicants' March 28, 2003, reply to the December 18, 2002, final Office action.

In view thereof, applicants request that the holding of abandonment of this application be withdrawn and that the finality of the December 18, 2002, Office

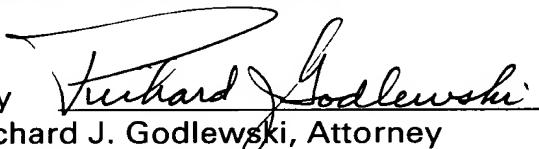
action be withdrawn and a new non-final Office action be sent to the applicants as indicated in the Examiner's interview summary of April 7, 2003.

Applicants submit this petition and request under 37 CFR 1.181, which does not indicate that a fee is required. However, should it be determined that payment of a fee is required for submittal of this petition and request, charge account 13-2528 for any such fee. Should this petition and request have been filed under another section of 37 CFR, this petition and request should be considered thereunder, and the payment of any necessary fee be charged to account 13-2528.

Respectfully submitted,

David Hartley
Michael Lawrence Brown

Date: Oct 7, 2003

By 
Richard J. Godlewski, Attorney
Reg. No. 30,056
(812) 330-1824

Enclosures:

December 18, 2002, Final Office Action (7 pages)
March 28, 2003, Amendment and Response to Final Office action (8 pages)
April 8, 2003, Interview Summary (3 pages)
August 14, 2003, Advisory Action (3 pages)
October 3, 2003, Notice of Abandonment (2 pages)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,270	11/24/1999	DAVID HARTLEY	PA-5169-CON	6069

9896 7590 12/18/2002
COOK GROUP PATENT OFFICE
P.O. BOX 2269
BLOOMINGTON, IN 47402



EXAMINER

HO, UYEN T

ART UNIT PAPER NUMBER

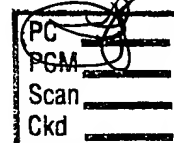
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DATE MAILED: 12/18/2002

Final Due 2/18/03

Please find below and/or attached an Office communication concerning this application or proceeding.

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DEC 23 2002

Office Action Summary

Application No.

09/449,270

Applicant(s)

HARTLEY ET AL.

Examiner

(Jackie) Tan-Uyen T. Ho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

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1) ☒ Responsive to communication(s) filed on 30 September 2002.2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-63 is/are pending in the application.4a) Of the above claim(s) 12-17 and 43-63 is/are withdrawn from consideration.5) ☒ Claim(s) 24-42 is/are allowed.6) ☒ Claim(s) 1-11 and 18-23 is/are rejected.7) ☐ Claim(s) _____ is/are objected to.8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).a) ☐ All b) ☐ Some * c) ☐ None of:1. ☐ Certified copies of the priority documents have been received.2. ☐ Certified copies of the priority documents have been received in Application No. _____.3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

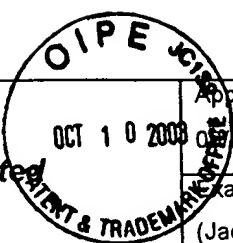
* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).a) ☐ The translation of the foreign language provisional application has been received.15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)4) ☐ Interview Summary (PTO-413) Paper No(s). _____.2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)5) ☐ Notice of Informal Patent Application (PTO-152)3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.6) ☐ Other: _____.

Notice of References Cited



Application/Control No.

05/149,270

Examiner

(Jackie) Tan-Uyen T. Ho

Applicant(s)/Patent Under
Examination
HARRIS ET AL.

Art Unit

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Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,352,553	03-2002	van der Burg et al.	623/1.23
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the longitudinal position" in lines 9-11 and claim 9 recites the limitation "the longitudinal and rotational position" in lines 7-8. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by van der Burg et al. (6,352,553).

In regard to claim 1, van der Burg et al. disclose an introducer for positioning an expandable prosthesis, the introducer including:

- A positioning mechanism releasable from the prosthesis (fig. 4A-4C)
- A first control member (306) separable from the positioning mechanism for retaining the prosthesis with the positioning mechanism and controlling at least a longitudinal position of the prosthesis
- A second control member (308) controlling at least the longitudinal position of the prosthesis

In regard to claims 2-4, wherein the positioning mechanism includes a distal attachment region having a distal attachment device (320) and a proximal attachment region having a proximal attachment device (321).

In regard to claims 6-7, wherein the positioning mechanism comprises an arrangement (318 and 324) for controlling the orientation of the prosthesis. Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the van der Burg et al.'s positioning mechanism which is capable of being used as claimed if one desires to do so.

In regard to claim 8, wherein the introducer includes an expansion control mechanism (holes on the elements 320 and 321 holding the first control member 306 temporary) controlling expansion of the prosthesis.

Allowable Subject Matter

5. Claims 24-42 are allowed over the prior art. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest an introducer having proximal and distal attachment devices attaching to a prosthesis in such a manner that the prosthesis can be held in tension there between and each end of the prosthesis can individually be moved in proximal and distal directions and be rotated independent of the other and proximal releasing means associated with and separable from the proximal and distal attachment devices to enable selective releasing of the proximal and distal ends of the prosthesis.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3731

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

(Jackie) Tan-Uyen T. Ho
December 12, 2002

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700